

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-7 were pending in this application. Claims 8-10 were added by this reply. Claim 8 is independent. The remaining claims depend directly from claim 8.

Claim Amendments

New claim 8 has been added by this reply. New claim 8 includes subject matter from original claim 1 and Figures 3 and 4 of the referenced application. Further, dependent claims 2-7 have been amended to depend from new claim 8 and be consistent with the amendments made to new independent claim 8. New dependent claims 9 and 10 include subject matter from original claim 1. No new matter has been added by any of the aforementioned amendments.

Rejection(s) under 35 U.S.C § 102

Claims 1, 3, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,440,773 ("Usami"). Claim 1 has been cancelled by this reply. Accordingly, this rejection is now moot with respect to cancelled claim 1. Pending claims 3 and 7 now depend from new independent claim 8. To the extent that this rejection applies to new independent claim 8 and amended pending dependent claims 3 and 7, the rejection is respectfully traversed.

New independent claim 8 is directed to a card like object. The card like object includes a

top face, a bottom face, a contactless chip, a contact chip, and an antenna. Further, the antenna is electrically connected to the contactless chip. In addition, the contactless chip and the contact chip are located in a cavity formed on a top face of the card (*see, e.g.*, Referenced Application, Figures 3 and 4).

Turning to the rejection, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (*See* MPEP § 2131). The Applicant respectfully asserts that Usami fails to disclose all the limitations of new independent claim 8.

Specifically, Usami fails to disclose a card like object that includes a top face with a cavity formed thereon. In contrast to the claimed invention, Usami clearly discloses that the chip(s) (contact and contactless) is embedded in the card (*see e.g.*, Usami, Figure 19, reference numeral 1922) and that the top face of the card is flat and does not include any cavities formed thereon (*see* Usami, Figure 19, reference numerals 1921).

Moreover, there is no disclosure of two chips (*i.e.*, the contactless chip and the contact chip) being located in the aforementioned cavity. In fact the disclosure of Usami is limited to embodiments in which the chip(s) is located on the surface of the card (*see e.g.*, Usami, Figure 10 and 13) or embodiments in which the chip(s) is embedded in the card (*see e.g.*, Usami, Figures 15, 18, 19, and 20).

In view of the above, Usami fails to disclose all the limitations recited in new independent claim 8. Thus, new independent claim 8 is patentable over Usami. Dependent claims 3 and 7 are patentable over Usami for at least the same reasons as new independent claim 8. Accordingly,

withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 103

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Usami in view of U.S. Patent No. 6,568,600 ("Carpier"). Claim 2 depends from new independent claim 8. To the extent that this rejection applies to new independent claim 8, the rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness "...the prior art reference (or references when combined) must teach or suggest all the claim limitations." (See MPEP §2143.03). Further, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (See MPEP §2143.03). The Applicant respectfully asserts that the cited references, whether considered separately or in combination, fail to teach or suggest all the limitations of new independent claim 8.

As discussed above, Usami does not teach or suggest all the limitations of new independent claim 8. Further, Carpier does not teach that which Usami lacks. This is evidenced by the fact that Carpier is only relied upon to teach "that the connecting means is a conductive track," (see Office Action, October 5, 2006, p. 3). Carpier is directed to provide an optimized connection that makes it possible to connect the conductive pins of a micromodule of a chip card to the ends of an antenna. However, Carpier is completely silent with respect to a card that includes a contact chip and a contactless chip located in a cavity formed on the surface of the card. Accordingly, new independent claim 8 is patentable over Usami and Carpier. Dependent claim 2 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Usami in view of U.S. Patent No. 6,566,163 ("Laroche"). Claim 4 depends directly from new independent claim 8. To the extent that this rejection applies to new independent claim 8, the rejection is respectfully traversed.

As discussed above, Usami does not teach or suggest all the limitations of new independent claim 8. Further, Laroche does not teach that which Usami lacks. This is evidenced by the fact that Laroche is only relied upon to teach "that the connecting means is a metallic wire," (*see* Office Action, October 5, 2006, p. 3-4). Laroche is directed to a contactless smart card where a gold wire is soldered to the chip contact pads. However, Laroche is completely silent with respect to a card that includes a contact chip and a contactless chip located in a cavity formed on the surface of the card. Accordingly, new independent claim 8 is patentable over Usami and Laroche. Dependent claim 4 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Usami in view of U.S. Patent Application Publication No. 2001-0050138 ("Fujikawa"). Claim 5 depends from new independent claim 8. To the extent that this rejection applies to new independent claim 8, the rejection is respectfully traversed.

As discussed above, Usami does not teach or suggest all the limitations of new independent claim 8. Further, Fujikawa does not teach that which Usami lacks. This is evidenced by the fact that Fujikawa is only relied upon to teach "that the connecting means is a liquid," (*see* Office Action, October 5, 2006, p. 4). Fujikawa is directed to an electronic circuit component electrically connected to an electric conductor pattern and fixed to a film by a fixing liquid. However, Fujikawa

is completely silent with respect to a card that includes contact chip and a contactless chip located in a cavity formed on the surface of the card. Accordingly, new independent claim 8 is patentable over Usami and Fujikawa. Dependent claim 5 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Usami in view of U.S. Patent Application Publication No. 2003-0183914 ("Wallace"). Claim 6 depends directly from new independent claim 8. To the extent that this rejection applies to new independent claim 8, the rejection is respectfully traversed.

As discussed above, Usami does not teach or suggest all the limitations of new independent claim 8. Further, Wallace does not teach that which Usami lacks. This is evidenced by the fact that Wallace is only relied upon to teach "that the chips are in a stacked configuration," (*see* Office Action, October 5, 2006, p. 4-5). Wallace is directed to semiconductor memory chip packaging, and in particular to stacked multiple memory chip packages. However, Wallace is completely silent with respect to a card that includes a contact chip and a contactless chip located in a cavity formed on the surface of the card. Accordingly, new independent claim 8 is patentable over Usami and Wallace. Dependent claim 6 is patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

New Claims

As discussed above, new claims 8-10 have been added by this reply. New independent claim 8, as discussed above, is patentable over the cited prior art. Further, new dependent claims 9 and 10 are patentable over the cited prior art for at least the same reasons as new independent

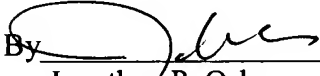
claim 8. Accordingly, favorable action in the form of a notice of allowability for the referenced application is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/056001).

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Respectfully submitted,

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